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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,733	02/25/2004	Frederick James Diggle III	BS 030 441	2744
38516 7590 07/29/2008 SCOTT P. ZIMMERMAN, PLLC PO BOX 3822 CARY, NC 27519				
EXAMINER				
WATSON, ROBERT C				
ART UNIT		PAPER NUMBER		
3723				
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07/29/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/786,733

Applicant(s)

DIGGLE ET AL.

Examiner

Robert C. Watson

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-11,13-19 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) 4-10 and 14-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,11,13,19 and 21-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the combination of the longitudinal portion with the spiral groove with the end portion having a plurality of grooves together must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. There is ambiguity in how to combine Figure 5 with Figure 8. Since the claims combine the structure in Figures 5 and 8 then the drawings must show this structural combination.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The amendment filed 6/6/08 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "The bottom floor 208 of each groove 53 also has a convex shape 218 such that a radius 220 of the bottom floor 208 of each groove 53 also has a convex shape 218 such that a radius 220 of the bottom floor 208 is less than, and concentric, to an outer radius 222 of the end portion 51". There is no clear support for this language. There is no support for it in the original description. As to the original drawings, the Figure 5 and 5A drawings are so poor as originally filed that it is the examiner's position that these Figures do not provide support for this language. The bottom wall appears to be straight particularly when viewing Figure 5. Also, Figure 10, which shows a somewhat similar structure shows the bottom wall to be straight. Taking all things into consideration the original disclosure shows a straight bottom not a convex bottom.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claims 1, 3, 11, 13, 19, 21, 22, and 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims have been amended to state for the very first time that "the bottom floor also having a convex shape such that a radius of the bottom floor is smaller than and concentric to an outer

radius of the end portion". There is no support in the description for this. The Figure 5 and 5A drawings are so poor as originally filed that it is the examiner's position that these Figures do not provide support for this language. The bottom wall appears to be straight particularly when viewing Figure 5. Also, Figure 10, which shows a somewhat similar structure shows the bottom wall to be straight. Taking all things into consideration the original disclosure shows a straight bottom not a convex bottom. Cancellation of the new matter from the claims is required.

Claims 1, 3, 11, 13, 19, 21, 22, and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear how the spiral groove at the end interacts with this "end portion comprising a plurality of grooves". Would the spiral groove intersect the "end portion comprising a groove"? It is unclear what is meant by a "mechanism for attaching a plurality of wire or cable engaging attachments to the end portion of the fish tape". The claims are ambiguous.

Claims 1, 3, 11, 13, 19, 21, 22, and 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is in no way apparent how wires are to be attached to the fish tape such that the wires or an attachment on the wires can be pulled by the fish tape. Is a wire to be somehow attached to the "end portion comprising a plurality of

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grooves"? If so how? Is it done by an attachment? If so how? How do these grooves function in pulling a wire? The disclosure in the specification and drawings is found to be fatally defective in answering these questions. Further, how does the spiral groove interact with the end groove? Do they intersect? How does that impact the wires to be pulled by the groove(s)? It is respectfully submitted that one skilled in the art would be unable to make and use the claimed device due to insufficient disclosure.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 11, 13, 19, 21, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noonan in view of Mikol and Jansch.

Noonan shows a fish tape 20 that is stored in a reel. Mikol teaches that a solid auger (Figure 1 and 3 embodiment) that is feed through a pipe has spiral groove on the exterior. To provide a spiral groove on the exterior of the fish tape 20 of Noonan would have been obvious for one skilled in the art at the time the invention was made in view of the disclosure of Mikol. One of ordinary skill in the art would have been motivated to do this in order to provide "the flexibility necessary" for the fish tape to be "rotated, twist and contorted within a pipe". To provide spiral grooves instead of a single spiral groove is seen to be no more than an obvious duplication of the Mikol teaching. Since the Mikol groove extends from one end of the device to the second end of the device, the end portion of course comprises a groove. To make the outer diameter of the fish

tape between .1875 and .375 is further obvious in view of the Mikol disclosure which contemplates such a range in the outer diameter.

Jansch teaches that an end of an elongate member may have a plurality of dovetail formations; eg. See 25 in Figure 9 of Jansch. To provide on the end of the elongate member fish tape of Noonan a plurality of dovetail formations would have been obvious in view of the Jansch disclosure. One skilled in the art would have been motivated to do this in order to facilitate a convenient and simple means for coupling the elongate fish tape to an object to be gripped by the fish tape. To provide dovetail grooves on the fish tape instead of formations would be no more than an obvious reversal of parts. Further, whether the base of the groove or slightly curved would be of immaterial difference and to make the base of the groove slightly curved would have been no more than an obvious matter of design choice absent a showing of criticality for this feature.

Claims 4-10 and 14-18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 11/21/05.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert C. Watson whose telephone number is 571 272-4498. The examiner can normally be reached on Mon. - Thurs. , 5:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph J. Hail III can be reached on 571 272-4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert C. Watson/

Primary Examiner, Art Unit 3723

rcw